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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,032	12/13/2000	James A. Savage	0894.0010	6624

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/736,032	Applicant(s) SAVAGE ET AL.	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,11,12,15,16,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8, 11, 12, 15, 16, 18, 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 2, 4-8, 11, 12, 15, 16, 18, 19 have been examined.

Response to Amendment

2. The Amendment filed on 5/7/04 is insufficient to overcome the Reilly, Goetz, and Kolls references.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5, 8, 11, 15, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (5,740,549) in view of Goetz (6,421,650) in view of Kolls (6,601,037).

Claim 1, 2, 4, 5, 8, 11, 15, 19:

Reilly discloses a hand-held electronic device comprising:

a central processing unit;

random accessible memory; a viewing screen;

a motherboard; a modem;

data entry means (col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45; col 8, lines 55-67);

Art Unit: 3622

at least one advertisement, the at least one advertisement being viewable on the viewing screen, the at least one advertisement being permanently stored on the device (col 3, lines 5-15).

Reilly further discloses that the at least one advertisement being chosen from the group comprising color highlighting of associated product, color background graphics identifying the product, video, animation, color, splash screen displayed in between a prescribing session, and company logo (Fig. 6; col 9, line 65-col 10, line 10; col 2, lines 4-25; col 13, lines 18-21); and, updating means for updating the at least one advertisement (col 3, lines 5-15).

Reilly further discloses updating the advertising via updating the software (col 5, lines 45-60; col 8, lines 5-10).

Reilly further discloses a signal converter (col 8, lines 55-67; col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45).

Reilly further discloses providing an electronic device remotely located (col 2, lines 67-col 3, line 5) and that a wide variety of computers can be used (col 4, lines 15-20);

Reilly does not explicitly disclose a hand-held device, printing information, or prescription writing means.

However, Goetz discloses a hand-held device (col 5, lines 35-41; Fig. 11), that the transmitted information is prescription information (Fig. 9; col 10, lines 17-23), printing the prescription information (col 6, lines 8-15).

Kolls further discloses audio, video, audio-visual (col 14, lines 50-55; col 33, lines 60-63) and coupon printing (col 17, lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goetz's prescription information and utilization of a PDA, and

Art Unit: 3622

Kolls advertisement features to Reilly's remote computer with locally stored advertising that gets updated. One would have been motivated to do this because a PDA is a standard type of computer, prescription information is standard type of information stored on a computer, and printing information is a standard feature of computers with interfaces so that the user can receive a hard copy of the information viewed.

Claim 6: Reilly, Goetz, and Kolls disclose the method of claim 4, and Reilly further discloses that the method further comprises the step of:
updating the advertising via the signal converter (col 8, lines 55-67; col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45).

4. Claims 7, 12, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (5,740,549) in view of Goetz (6,421,650) in view of Kolls (6,601,037) in view of Lupi (5,755,462).

Claim 7: Reilly, Goetz, and Kolls disclose the method of claim 4. Reilly does not explicitly disclose printing a prescription with the advertising on the prescription.

However, Lupi discloses printing the at least one advertisement on the prescription information (col 2, lines 7-11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Lupi's printing the advertisement with the prescription information to Reilly's remote computer with locally stored advertising and information that gets updated. One would have been motivated to do this because printing information and associated advertisements increases the chance that the user will notice the related advertisement.

Art Unit: 3622

Claim 12, 16: Reilly discloses a method, medium for advertising, the method comprising the steps of:

providing an electronic device remotely located (col 2, lines 67-col 3, line 5) and that a wide variety of computers can be used (col 4, lines 15-20); and,

providing at least one electronic advertisement on the device, the advertisement being permanently stored on the device (col 3, lines 5-15);

transmitting information (col 3, lines 5-15).

Reilly further discloses updating the at least one advertisement (col 3, lines 5-15).

Reilly does not explicitly disclose a hand-held device, that the advertisements are banner advertisements or that the transmitted or printing information or that printed information is prescription information.

However, Goetz discloses a hand-held device (col 5, lines 35-41; Fig. 11), that the transmitted information is prescription information (Fig. 9; col 10, lines 17-23), printing the prescription information (col 6, lines 8-15).

Goetz further discloses advertising information (col 6, lines 64-66).

However, Kolls discloses that banner advertisements can be displayed on a PDA (col 3, lines 63-65; col 33, lines 60-65; col 34, lines 3-5) and that advertisement information and other information can be printed (col 35, lines 60-65).

However, Lupi discloses printing the at least one advertisement on the prescription information (col 2, lines 7-11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goetz's prescription information and utilization of a PDA, Kolls'

Art Unit: 3622

banner advertisements, and Lupi's printing the advertisement with the prescription information to Reilly's remote computer with locally stored advertising that gets updated. One would have been motivated to do this because a PDA is a standard type of computer, prescription information is standard type of information stored on a computer, a banner is a standard type of electronic advertisement, and printing information and associated advertisements increases the chance that the user will notice the related advertisement.

Claim 18: Reilly, Goetz, Kolls, and Lupi disclose the computer readable medium of claim 16, wherein providing at least one electronic banner advertisement for an electronic hand-held device, the at least one advertisement being permanently stored on the electronic hand-held device, comprises:

providing at least one electronic banner advertisement for an electronic hand-held device, the at least one advertisement being permanently stored on the electronic hand-held device, the device having a central processing unit, random accessible memory, a mother board, a signal converter, and data entry means (col 6, lines 25-30; col 1, lines 12-21; col 11, lines 43-45; col 8, lines 55-67).

Response to Arguments

5. Applicant's arguments with respect to claims 1, 2, 4-8, 11, 12, 15, 16, 18, 19 have been considered but are not found persuasive

On page 7 of the Applicant's Amendment dated 5/7/04, Applicant states that, "Nothing in either the Reilly or Kolls references discusses or contemplates the inclusion of their invention on to a hand-held device."

However, Reilly discloses that the users computer have memory, a processor, and Internet access (col 6, lines 25-32).

Kolls discloses the utilization of a palm pilot, personal digital assistant (PDA), and other portable devices (col 3, lines 59-67).

Goetz discloses the utilization of a palm pilot, personal digital assistant, and other portable devices (col 5, lines 35-42).

Therefore, it would be obvious to one of ordinary skill in the art that the Reilly device can be of many variations such as a palm pilot or PDA. One would be motivated to do this to provide convenient access and portable utilization of Reilly's disclosure over the Internet.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Note that the pertinent knowledge is knowledge within the level of the ordinary skill in the art at the time the Claimed Invention Was Made. Because of the Provisional Application, the Applicant's reference has priority to 1/25/2000. Therefore, any knowledge within the ordinary skill of the art before 1/25/2000 can be possible prior art. Reilly, Goetz, and Kolls all have

Art Unit: 3622

priority dates earlier than the Applicant's. Therefore, Reilly, Goetz, and Kolls, which all existed before 1/25/2000, have been combined in a USC 103(a) rejection and can be considered together regardless of how old one reference is in relation to another reference. The state of the art in relation to the Applicant's claimed invention is the relevant skill in the art prior to 1/25/2000. That is, one does not look at the state of the art in reference to the Applicant's claimed invention from the vantage point of Reilly's filing date of June 12, 1995. Rather, one looks at the state of the art from the vantage point of the Applicant's priority date, which is 1/25/2000.

On page 8 of the of the Applicant's Amendment dated 5/7/04, Applicant states that a hand-held device that allows prescription writing is not disclosed.

However, Goetz discloses a hand-held device that allows prescription writing (col 5, lines 44-52; col 5, lines 35-40).

On page 9 of the of the Applicant's Amendment dated 5/7/04, Applicant states, "However, in col 6, lines 8-15 of Goetz, there is no mention of printing anything."

However, Goetz (6,421,650) column 6, lines 8-15 does disclose printing,

"Today, this data is typically printed on a sheet (typically 5.5" by 8") that contains common uses, consumption requirements, cautions and possible side effects of the particular medication. Thus the pharmacist component 18 in the system 10 of the present invention, through the pharmacist's PC, reads and write data from the pharmacist's database to the memory device 14 , and will typically supply the data that is conventionally printed on the prescription information sheet to the memory device 14 in addition to medication administration instructions.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art that is being referred to.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

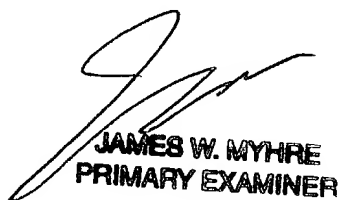
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



5/10/04



JAMES W. MYHRE
PRIMARY EXAMINER